

REMARKS

This amendment is in response to the Office Action mailed on November 1, 2006 in which claims 1-17 were rejected. With this amendment, claims 18-29 are cancelled without prejudice. Applicant respectfully requests reconsideration of the present application in view of the reasons that follow.

I. Election/Restriction Requirement

On page 2 of the Office Action, the Examiner indicated that claims 1-17 will be included for examination in the present application. Accordingly, Applicant has cancelled non-elected claims 18-29 with this amendment.

II. Rejection of Claims 1-8 and 13-17 Under 35 U.S.C. § 102(b) as Anticipated by Grayson

On page 2 of the Office Action, the Examiner rejected claims 1-8 and 13-17 under 35 U.S.C. § 102(b) as anticipated by Grayson, U.S. Patent No. 6,210,376. Applicant respectfully traverses the rejection under Grayson.

Independent claims 1 and 13 each recite “wherein the insert is cannulated along at least a portion of its length.” Independent claim 1 further recites “one or more insert fenestrations disposed along the cannulated portion of the insert” and claim 13 further recites “wherein the insert is permeable to the substance to be delivered to the bone.” Grayson does not identically disclose an insert having a cannulated portion, fenestrations, or a permeable portion. In contrast, Grayson discloses a “trocar 11” comprising “a pin 60 having a tip end 61 and a handle end 62.” See col. 5, lines 2-4 and Fig. 2. The trocar 60 appears to have a solid shaft, which is not cannulated, does not include fenestrations, and further does not include a permeable area. Accordingly, independent claims 1 and 13 and corresponding dependent claims 2-8 and 12-17 are not anticipated under 35 U.S.C. § 102(b) and are presented for reconsideration and allowance.

III. Rejection of Claims 9-10 Under 35 U.S.C. § 103(a) Based Upon Grayson in View of Miller et al.

On page 3 of the Office Action, the Examiner rejected claims 9-10 under 35 U.S.C. § 103(a) as unpatentable over Grayson in view of Miller et al., U.S. Patent No. 6,228,088. As discussed above, Grayson does not identically disclose each of the elements of independent claim 1. Miller et al. does not overcome the deficiencies of Grayson. The “intramedullary catheter 10” of Miller et al. does not appear to include any insert. Accordingly, dependent claims 9-10, which depend from independent claim 1, are presented for reconsideration and allowance.

IV. Rejection of Claims 11-12 Under 35 U.S.C. § 103(a) Based Upon Grayson in View of Wigness et al.

On page 4 of the Office Action, the Examiner rejected claims 11-12 under 35 U.S.C. § 103(a) as unpatentable over Grayson in view of Wigness et al., U.S. Patent No. 5,203,770. As discussed above, Grayson does not identically disclose each of the elements of independent claim 1. The “method and apparatus for catheterization” of Wigness et al. does not remedy the deficiencies of Grayson. The “cannula arrangement 41” of Wigness et al. does not appear to include fenestrations or a permeable area. See col. 7, lines 54-59 and FIG. 4. Accordingly, claims 11-12, which depend from independent claim 1, are presented for reconsideration and allowance.

V. Conclusion

Claims 1-17 are pending in the present application. Claims 18-29 have been cancelled without prejudice. Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date January 11, 2007

By /Jeffrey S. Gundersen/

FOLEY & LARDNER LLP
Customer Number: 23524
Telephone: (414) 297-5897
Facsimile: (414) 297-4900

Jeffrey S. Gundersen
Attorney for Applicant
Registration No. 47,619